



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,171	03/05/1999	LESLIE STROH	STROH	2689

545 7590 06/02/2005

ANTHONY H. HANDAL  
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP  
599 LEXINGTON AVENUE  
33RD FLOOR  
NEW YORK, NY 10022-6030

EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/264,171	<b>Applicant(s)</b> STROH, LESLIE	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-80 and 92-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 35-80 and 92-101 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

A

Art Unit: 3624

### **DETAILED ACTION**

1. Claims 35-80 and 92-101 are pending. Claims 35-39, 41, 43, 44, 62, 64, 66, 68, 75, 95-97, and 99-101 been amended in this communication filed 03/03/05 entered as Supplemental Response.
2. The Response After Non-Final Action filed 02/28/05 has been entered.
3. Applicants' 35 U.S.C. 101 Rejection has not been overcome by the amendments to claims 35 and 44 and still stand rejected as set forth here below. The amendment to claims 64, 68, 75, 100, and 101 have overcome the 35 U.S.C. 101 rejection and the rejection for those claims is hereby withdrawn.

### ***Claim Objections***

4. Claim 100 is objected to because of the following informalities: Claim 100, lines 10 and 11 recites "1<sup>st</sup> bill of exchange ..., 1<sup>st</sup> bill of exchange, and 2<sup>nd</sup> bill of exchange." This claim limitation should be recited as "first bill of exchange ..., first bill of exchange, and second bill of exchange". Claims 44 and 64 and any other claims that recite "bill-of-exchange" and in the other claim limitations recite "bill of exchange". The claims should either recite either "bill-of-exchange" or "bill of exchange". Claims containing "pro-forma" have a similar problem. This is inconsistent in the claims. Appropriate correction is required.

### ***Abstract***

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract

Art Unit: 3624

on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because line 3 recites "first bill of exchange (1o E) and uses parenthesis through out the Abstract. Applicant is advised to review the Abstract of the previously cited references for the preferred and proper format of an Abstract. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 101***

6. Claims 35 and 41 and claims 36-40, 42, 43, and 45-61 that depend therefrom are rejected under 35 USC 101 as non-statutory. The method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claims may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 USC 101. In contrast, a method claim that includes in the body of the claim at least one structural/ functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) –used only for content and reasoning since not precedential]. The preamble of independent claims 35 and 44 or the body of the claims do not recite "A computerized method" or "A computer-implemented method" or a machine or device to perform the method steps that follow.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 35-41 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Specification throughout references payment draft and bill-of-exchange and does not reference "latent payment draft" or "latent first bill-of-exchange". The Specification references "payment draft" and "first bill-of-exchange". Applicant needs to either amend the Specification or to remove "latent" from claims 35-41 and 43 in order for the claims to be in agreement with the Specification.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 35, 44, and 75 are rejected under 35 U.S.C. 112 second paragraph.

Claim 35 recites the limitation "prerelease latent payment draft" in line 6 and recites latent payment draft in line 4 and line 6 on page 3. Claim 44 recites "prerelease latent first bill-of exchange" in line 5 on page 5 and "first bill of exchange" on page 5, line 3 and page 6, line 2. Claim 75 recites the limitation "payment draft" in line 2, page 15

Art Unit: 3624

and this limitation is not found in the other claim limitations of claim 75. There is insufficient antecedent basis for these limitations in the claims.

***Election/Restrictions***

11. This application contains claims directed to the following patentably distinct species of the claims invention:

Species 1(A), the buyer providing an event-activated, latent payment draft to the seller or the seller's agent prior to release of the traded product from the seller's control wherein the event-activated prerelease latent payment draft performs the method for financing the sale of a traded product as claimed in claim 35.

Species 1(B), the prerelease latent payment draft is also executed by the seller prior to the activating event, as claimed in claim 36.

Species 1 (C ), the activating event comprises the release of the traded product from the seller's control and the sell releases the traded product to receipt by the seller of the prerelease latent payment draft, as claimed in claim 37.

Species 2 (A), the prerelease latent payment draft comprises a transaction window containing transaction identifiers that permit identification of the transaction comprising the sale of the traded product, as claimed in claim 38.

Species 2 (B), the transaction window occupies a distinct area on the prerelease latent payment draft separate from the payment draft characteristics and the transaction identifiers, as claimed in claim 39.

Species 2 (C ), the transaction identifiers comprise a seller identification number, a proforma invoice identification number, ..., as claimed in claim 40.

Art Unit: 3624

Species 3 (A), the prerelease latent payment draft being generated by software running on a computer, wherein the prerelease payment draft comprises an electronic file or paper document printed from an electronic file, ..., as claimed in claim 41.

Species 3 (B), wherein the seller is an exporter in one country, the buyer an importer in another country, state or region, ..., as claimed in claim 42.

Species 3 (C ), wherein the prerelease latent payment draft comprises an electronic file, or a paper printed from an electronic file, ..., as claimed in claim 43.

Species 4 (A), the buyer providing an event-activated first bill-of-exchange to the seller or the seller's agent prior to release of the traded product from the seller's control wherein the event-activated prerelease latent first bill-of-exchange and the buyer executing a second bill of exchange, ..., as claimed in claim 44.

Species 4 (B), substituting a banker's acceptance for the first bill of exchange, as claimed in claim 45.

Species 5 (A ), furnishing a pro-forma invoice to the buyer before execution of the first bill of exchange by the buyer ..., as claimed in claim 46.

Species 5 (B), the pro-forma invoice includes a contractual condition removing merchandise claims or disputes from the payment cycle ..., as claimed in claim 47.

Species 5 (C ), the pro-forma invoice comprises information ..., as claimed in claim 48.

Species 5 (D), the trade is an international transaction and wherein the pro-forma invoice further comprises information ..., as claimed in claim 49.

Art Unit: 3624

Species 6 (A), the seller and the buyer contracting to remove merchandise claims or disputes from the payment cycle for resolution with international convention or treaty, as claimed in claim 50.

Species 6 (B), the trade is an international transaction, wherein the method comprises furnishing a pro-forma invoice to the buyer before execution ..., as claimed in claim 51.

Species 6 (C) , a purchase agreement signed by the buyer with the purchase agreement providing ..., as claimed in claim 52.

Species 7 (A), the first bill of exchange made out in the amount of the pro-forma invoice and the pro-forma invoice linked to the first bill of exchange, for use in initiating a draft substitution process, as claimed in claim 53.

Species 7 (B), the first bill of exchange is completed and executed by the buyer for re-presentation to the buyer for payment at a later date, as claimed in claim 54.

Species 7 (C) , being an international trade transaction, comprising a financial institution capable of issuing a banker's acceptance, ..., as claimed in claim 55.

Species 7 (D), the seller notifying the financial institution or its service intermediary, ..., as claimed in claim 56.

Species 7 (E), the transaction advances if the acceptance-issuing institution approves the buyer and the transaction is aborted if the transaction or the buyer is not-approved, as claimed in claim 57.

Species 7 (F), after receiving the approval of the acceptance-issuing institution, the seller releases the traded product to the buyer and wherein such release comprises



Art Unit: 3624

the activating event initiating the term of the first bill of exchange, as claimed in claim 58.

Species 7 (G), not before release of the traded product to the buyer, the seller sends an invoice for the product along with a second bill of exchange to the buyer's bank, as claimed in claim 59.

Species 7 (H), the second bill of exchange includes unique transaction identifiers and contains instructions to the buyer to pay on a date certain sum of money to the account of the acceptance-issuing institution, ..., as claimed in claim 60.

Species 7 (I), the buyer's bank holding the buyer-signed second bill of exchange to maturity; ..., as claimed in claim 61.

Species 8 (A), the first bill of exchange is electronically generated and electronically transmitted to the buyer, ..., as claimed in claim 62.

Species 8 (B), the first bill of exchange, the second bill of exchange, the pro-forma invoice and the invoice is or are electronically generated ..., as claimed in claim 63.

Species 9 (A), acceptance by the buyer of the first bill of exchange ordering payment for the traded product to be made by the buyer at a maturity date subsequent to the date of acceptance of the first bill of exchange ..., as claimed in claim 64.

Species 9 (B), the first bill of exchange has a maturity date determined as a fixed period ..., as claimed in claim 65.

Species 9 (C), generating the first and second bills of exchange, as claimed in claim 66.

Species 9 (D), the trade is a domestic transaction, the buyer and the seller being located in the same country, state or region, ..., as claimed in claim 67.

Species 10 (A), the seller making an offer to the buyer by providing the buyer computer-generated documents: ..., as claimed in claim 68.

Species 10 (B), the pro-forma invoice and first bill of exchange are separately executed and, ..., as claimed in claim 69.

Species 10 (C ), the pro-forma invoice includes: i) an agreement that the buyer will pay against the first or the second bill of exchange to be issued after the activating event; and ii) a non-recourse agreement to contractually remove trade disputes from the payment cycle, as claimed in claim 70.

Species 10 (D), the pro-forma invoice is signed by both the buyer and seller before release of the traded product by the seller, as claimed in claim 71.

Species 10 (E), after activating the event and, if the activating event is not a release of the traded product, after release of the traded product, the seller issues a second bill of exchange and wherein the first and second bills of exchange are each designated on their faces as being payable ..., as claimed in claim 72.

Species 10 (F), the first bill of exchange, the pro-forma invoice, the invoice and the second bill of exchange are all issued by one of the seller and the buyer ..., as claimed in claim 73.

Species 10 (G), prior to the activating event, a financial institution providing a banker's acceptance with respect to the first bill of exchange held as collateral, as claimed in claim 74.

Species 11 (A), the buyer executing a pro-forma invoice having indicia indicative of the traded product: ..., as claimed in claim 75.

Species 11 (B), the accepted and executed first bill of exchange and the accepted and executed second bill of exchange are mutually extinguishable ..., as claimed in claim 76.

Species 11 (C ), the buyer's transaction agent remitting a payment to the financial institution; and the financial institution paying a payment to the holder of the bank's acceptance; ..., as claimed in claim 77.

Species 11 (D), the seller notifies a third party administrator respecting the execution and sending of the first bill of exchange and the pro-forma invoice ..., as claimed in claim 78.

Species 11 (E), the event is the release of goods or performance of services, the goods or services comprising the traded product, as claimed in claim 79.

Species 11 (F), the event which triggers the legal obligation of the buyer is the seller's parting with physical control of the goods or the seller's performing the service, as claimed in claim 80.

Species 12 (A), c) the financial institution making the payment of the specified amount of money to the seller, as claimed in claim 92.

Species 12 (B), d) the seller presenting the payment draft to the financial institution for collateral or collection, as claimed in claim 93.

Species 12 (C ), e) the financial institution collecting payment for the payment draft from the buyer, as claimed in claim 94.

Species 12 (D), the payment draft is transaction-independent and the activating event comprises release of the traded product from the seller's control, ..., as claimed in claim 95.

Species 12 (E), the payment draft has a term calculated from the specified event data of at least 30 days, or of 60, or 90 or 180 days, as claimed in claim 96.

Species 12 (F), the payment draft is specified on its face as being the first of a set of two mutually extinguishable payment drafts, as claimed in claim 97.

Species 12 (G), the traded product consists essentially of goods, of services or of goods and services, as claimed in claim 98.

Species 12 (H), not before the release of the traded product to the buyer, the seller issues an invoice for the traded product, the proforma invoice references the first bill of exchange and the invoice references the second bill of exchange and the proforma invoice, ..., as claimed in claim 99.

Species 12 (I), not before release of the traded product, the seller issues an invoice for the traded product, the invoice references the proforma invoice and the first bill of exchange, ..., as claimed in claim 100.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. **In this instance the Applicant must select one of species 1 (A-C) and one of species 2 (A-C) and one of species 3 (A-C) and one of species 4 (A-B) and one of species 5 (A-D) and one of species 6 (A-C) and one of**

Art Unit: 3624

**species 7 (A-I) and one of species 8 (A-B) and one of species 9 (A-D) and one of species 10 (A-G) and one of species 11 (A-F) and one of species 12 (A-I).**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 101 is considered to be a generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim. Applicant will be entitled to the consideration of the claims to additional species which are written in dependent form or otherwise include all of the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Art Unit: 3624

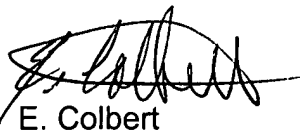
Should the Applicant select one of the claims in one of the species that is rejected or objected to, it is respectfully requested that the claim be amended.

***Inquiries***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert  
May 26, 2005